RECORD AND BRIEF

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IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF *AMICUS CURIAE* SAN FRANCISCO DYKES ON BIKES WOMEN'S MOTORCYCLE CONTINGENT, INC.

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INTEREST OF THE *AMICUS CURIAE*[1]

Amicus Curiae San Francisco Dykes on Bikes Women's Motorcycle Contingent, Inc. ("Dykes on Bikes") is a non-profit organization composed of lesbian motorcycle riders and their allies. The Dykes on Bikes first appeared in the 1976 San Francisco Pride parade and have led the San Francisco Pride parade and many other cities' Pride parades ever since as representatives of the movement for lesbian, gay, bisexual, transgender, and queer ("LGBTQ") equality and empowerment.

The Patent and Trademark Office ("PTO") has by turns both accepted and rejected Dykes on Bikes' trademark applications, depending on the time and the particular examiner assigned to the case. This includes various rejections on the ground that the term "dyke" is a disparaging term for lesbians, and, conversely, an acceptance based on extensive evidence from Dykes on Bikes that the term "dyke" is not a disparaging term, including almost two dozen expert declarations from distinguished linguists, historians, and authors.

Dykes on Bikes has no direct interest in the outcome of this case, but does have an interest in being able to register and control the use of its trademarks, which the PTO has interfered with by rejecting Dykes on Bikes' Design Mark trademark application and by applying

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1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the *amicus curiae*, or its counsel made a monetary contribution to its preparation or submission. The parties have consented to the filing of all brief in this matter.

its registration criteria arbitrarily and inconsistently. Dykes on Bikes has a trademark application that has been suspended pending the result of this case.

SUMMARY OF ARGUMENT

Amicus Dykes on Bikes is a non-profit organization composed of lesbian motorcycle riders and their allies. Dykes on Bikes uses its trademark to cultivate a brand of political activism and awareness, supporting the civil rights of lesbians and working to fight harmful stereotypes about lesbians and the entire LGBTQ community. The purpose of the brand is not to sell commercial goods or services. Rather, Dykes on Bikes requires all its Chapters around the world to use the brand for charitable and political expression in support of its civil rights mission. Amicus purposefully and intentionally adopted the term "dykes" as part of its trademark in order to highlight and confront the controversial history of that term and dispel the notion that it is disparaging. It uses its trademark to prevent the commercial exploitation of its name or logo, which Dykes on Bikes believes would corrupt and dilute its ability to use its mark to advance its political and social message.

The process of obtaining trademark registrations from the PTO has been costly, time-consuming, and ultimately only partially successful because each application is subject to the whim of the particular trademark examiner assigned and his or her particular biases in applying 15 U.S.C. § 1052(a). Different PTO examiners have at various times both accepted and rejected Dykes on Bikes' trademark applications, depending on the particular examiner assigned to the case and their changes in mind.

It has at various points found both that the term "dyke" is a disparaging term for lesbians and, conversely, that the term "dyke" is not a disparaging term.

This difficulty in registering its trademarks has made it nearly impossible to keep the Dykes on Bikes brand focused on political speech. Dykes on Bikes has struggled to prevent other users from attempting to commercialize the mark. Websites like eBay, Facebook, and Zazzle.com require trademark registration numbers for takedown notices, and some sites refuse to honor takedown notices without proof of a federal trademark registration. This leaves the Dykes on Bikes logo vulnerable and threatens to deprive the Dykes on Bikes name of protection as the PTO contemplates reversing its earlier ruling and invalidating the organization's existing mark. The reality is that federal trademark registration is often a prerequisite to effective enforcement. Without the power of a registered trademark, the public is left confused and unable to distinguish Dykes on Bikes' political speech from the speech of unrelated, unaffiliated entities looking to make money off the Dykes on Bikes brand.

Dykes on Bikes' experience with Section 1052(a) offers three lessons that may help the Court in resolving this case:

1. Trademark registration is not useful only for commercial speech. It can also be critical for entities engaged in political speech. Dykes on Bikes is a non-profit organization focused on political speech and social action, not commercialization. Dykes on Bikes uses its trademarks for three reasons: (1) to identify itself when it is engaged in its own political speech; (2) for members to

publicly self-identify as proudly out-of-the closet lesbians, publicly appropriating the very words previously used to shame them into silence and submission as well as claiming those words as a source of pride and as a rallying cry for winning equal rights under the law; and (3) to prevent for-profit companies from trying to profit from the well-known Dykes on Bikes trademark by selling products of their own with no benefit, oversight, or approval from the actual Dykes on Bikes organization. Section 1052(a) does not simply burden speech that proposes a commercial transaction. As applied to Dykes on Bikes, it directly affects our ability to engage in core political speech undiluted by misleading commercial messages.

2. The PTO's application of Section 1052(a)'s prohibition on "disparaging" trademarks is arbitrary and inconsistent, depending on the opinions, biases, and standardless discretion of the particular PTO examiner assigned to the case. The Federal Circuit decision now on appeal lamented the inconsistent application of Section 1052(a), pointing out that the PTO denied trademark registration for HAVE YOU HEARD SATAN IS A REPUBLICAN, but granted the trademark application for THE DEVIL IS A DEMOCRAT. *See In re Tam*, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *cert. granted sub nom., Lee v. Tam*, 137 S. Ct. 30 (Sept. 29, 2016). But it is worse than that. The PTO has both accepted and rejected marks using exactly the same words. In 2007, the PTO issued a certificate of registration for the word mark "Dykes on Bikes," albeit only after the examiner's refusal to register the mark was reversed on appeal. DYKES ON BIKES, Reg. No. 3,323,803 File History ("'803 FH"), Registration Certificate (Oct. 30, 2007). Dykes on Bikes then filed its declaration of use and

incontestability in 2013. *Id.*, Decl. of Use & Incontestability (Oct. 30. 2013). But in 2016, when Dykes on Bikes applied to register its logo, which also includes the words "Dykes on Bikes," the PTO rejected the application on the basis that the word "dyke" was disparaging, despite the 2007 finding to the contrary and despite issuing a certificate of use and incontestability for the same words only two years earlier. DYKES ON BIKES W M C, U.S. Trademark Serial No. 86/609,566 File History ("'566 FH"), Suspension Notice (Oct. 15, 2016). The PTO argues that it is not bound by its prior decision on the same words, insisting upon its right to render inconsistent rulings.

The long, costly, and uncertain process of obtaining trademark registration has imposed a substantial burden on Dykes on Bikes. Trademark examiners demanded an extraordinary amount of evidence, far beyond what is required of other trademark applicants, before registering the Dykes on Bikes word mark. And some examiners accept that evidence while others reject it, applying a subjective standard for identifying "disparaging" words. The inconsistency of the PTO in registering other marks that use words with a history of disparaging meaning, like QUEER AS FOLK and BITCH, while refusing to register the Dykes on Bikes design mark, further demonstrates the arbitrariness of the standard. Dykes on Bikes' experience is a cautionary tale about delegating hundreds or thousands of discretionary free speech decisions to individual civil servants working with no clear or objective standard. It is also a healthy reminder why the First Amendment strongly disfavors this kind of content-based prior licensing restraint on speech.

3. Federal trademark registration matters. Without registration, it may be practically and financially impossible for Dykes on Bikes—or any small political activist organization—to effectively ensure that the public understands the difference between Dykes on Bikes' own political speech, and speech from others, which might be commercial or contain anti-gay political messages falsely claiming to come from Dykes on Bikes.

Some courts—and petitioners—suggest that even if the PTO rejects a mark as disparaging, the trademark owner can invoke common-law rights. But common-law rights are not adequate. Trademark registration confers a number of legal advantages that a common-law right to bring a lawsuit does not, including the statutory presumption of validity, nationwide priority, incontestability, proof that the mark has secondary meaning, and constructive notice to would-be infringers. Registration also confers significant practical advantages not mentioned in the statute, particularly for small companies or non-profit organizations such as Dykes on Bikes. Effective enforcement is practically impossible without a trademark registration or the money to file countless common-law trademark lawsuits.

Trademark registration, then, is not simply a benefit conferred by the government that can be replaced by the consolation prize of common-law rights for those whose speech the government disfavors. Registration is an integral part of the federal trademark scheme and an integral part of an organization's ability to effectively name and brand itself.

ARGUMENT

A. DYKES ON BIKES AND THE TRADEMARK REGISTRATION ODYSSEY

1. Dykes on Bikes is a non-profit organization dedicated to helping LGBTQ people have pride and dignity in their sexual orientation and to engage in philanthropic efforts in the LGBTQ and women's communities. It is based in San Francisco, and has about 15 official chapters throughout the U.S. and the world. The San Francisco chapter oversees the official chapters and ensures that the organization as a whole maintains a united vision for advancing LGBTQ and women's rights.

The organization first formed in 1976, when a small contingent of women motorcyclists gathered at the head of the San Francisco Pride parade. That first year, they coined the informal name "Dykes on Bikes." Consistent with the "pride" theme, they chose to use the name "dykes" precisely because of its history as a slur. The message it conveyed was, in part, that being a dyke was not something to be ashamed of. Rather than remaining hidden in private homes and clubs, lesbians could be out and proud, riding powerful machines at the front of parades celebrating the civil rights of LGBTQ people. The societal and personal impact of the Dykes on Bikes trademark has helped transform "dyke" from an epithet to a word commonly used by lesbians to refer to themselves with pride.

2. In 2003, the organization officially changed its name to the San Francisco Dykes on Bikes Women's Motorcycle Contingent. Dykes on Bikes filed its application to register

the phrase DYKES ON BIKES as a trademark on July 31, 2003, beginning a saga that continues to this day without a final resolution.

Trademark examiners initially refused to register the mark. '803 FH, Office Action (Feb. 20, 2004). Overcoming that resistance required Dykes on Bikes to submit evidence far beyond what is required of other trademark applicants and to win an appeal. Throughout the process, Dykes on Bikes met with hostility and resistance from the PTO.

Dykes on Bikes first provided evidence to the PTO that the term "dyke" is not disparaging, but the PTO rejected the application. *Id.*, Request for Reconsideration (April 26, 2005). Dykes on Bikes appealed. TTAB Appeal of Appliction Serial No. 78/281,746 ("Appeal") (April 28, 2005). We offered declarations from 23 expert witnesses, including LGBTQ scholars, historians, and lexicologists to show that the term is not derogatory. *Id.* Rather than cite similarly competent evidence during the appeal, the PTO attempted to support its position with a printout of an unidentified individual's webpage purporting to provide personal translations of "vulgar" words from English into Spanish. *Id.*, Reconsideration Denial (May 26, 2005). It was not a list of "disparaging" words, but a list of "vulgar" words including "dyke," "breasts," "testicles," "clitoris," "condom," and many other words which could not be considered "disparaging" under Section 2(a). The PTO also offered a print out of an online dictionary combining references from an out-of-print 1913 Webster's dictionary and personal notations by the individual who hosted the website, where the only reference to "dyke" as "vulgar, deprecatory" appears in a personal notation.

On November 2, 2005, the Trademark Trial and Appeals Board remanded the case to the PTO, which published the DYKES ON BIKES mark for opposition on January 4, 2006. *Id.*, Remand (Nov. 2, 2005); '803 FH, Notice of Publication (Jan. 4, 2006).

The PTO finally registered the Dykes on Bikes mark in October 2007, and in 2013 accepted the certificate of use and incontestability. '803 FH, Registration Certificate (Oct. 30, 2007); *id.*, Notice of Acceptance (Nov. 15, 2013).

However, only two years after accepting the incontestability certificate for the trademark on the words Dykes on Bikes, the PTO rejected Dykes on Bikes' new application to register a trademark in its logo on the basis of those same words. '566 FH, Office Action (Aug. 11, 2015). That should not have been a controversial or difficult request, since a mark limited to words plus a design is narrower than the already-registered word mark. Yet despite the PTO's determination after remand from the TTAB in the prior case that the words "Dykes on Bikes" are not disparaging and are eligible for trademark registration, a new trademark examiner decided to reverse course and reject the design mark application, setting Dykes on Bikes' work back twelve years. The PTO examiner has stood by this rejection even after Dykes on Bikes incorporated all the evidence from the prior word mark application into the record along with new evidence that the mark is not disparaging. The examiner has stood by this rejection despite the fact that not one lesbian has ever raised any objection to registration of "Dykes on Bikes" during this entire thirteen year trademark registration effort. The examiner has suspended Dykes on Bikes' design mark application pending the outcome

of this case, *Lee v. Tam*. It is a particularly frustrating result for Dykes on Bikes, which continues to struggle to control its brand without federal trademark registration.

B. DYKES ON BIKES' TRADEMARKS ARE POLITICAL SPEECH, NOT COMMERCIAL SPEECH

1. Dykes on Bikes adopted its trademarked name as a form of political speech. Dykes on Bikes does not exist to sell products. It is a non-profit organization that exists to communicate a political and social message. Indeed, the value of its trademark registration is precisely that it enables Dykes on Bikes to keep the use of its mark political rather than allowing it to be diluted with commercial messages. Dykes on Bikes uses its trademarks to prevent others from commercializing the term "Dykes on Bikes" and to prevent others from attributing others' speech to the Dykes on Bikes organization.

This use of a trademark for self-identification furthers a core purpose of the First Amendment. The First Amendment does not merely protect the availability of messages from various viewpoints. It also protects the right of individuals to associate their identities with the messages they seek to convey. As this Court explained in *City of Ladue v. Gilleo*, 512 U.S. 43 (1994), in the course of striking down an ordinance that prohibited signs on residential property, "[p]recisely because of their location, such signs provide information about the identity of the 'speaker.' [And] . . . the identity of the speaker is an important component of many attempts to persuade." *Id.* at 56. A trademark allows Dykes on Bikes to identify as a group by using language that invokes the members' own

identities. That ability to associate individual identity with group identity and communicate a message unique to that group is central to the First Amendment. *See Roberts v. United States Jaycees*, 468 U.S. 609 (1984) ("[T]he Court has recognized a right to associate for the purpose of engaging in those activities protected by the First Amendment — speech, assembly, petition for the redress of grievances, and the exercise of religion. The Constitution guarantees freedom of association of this kind as an indispensable means of preserving other individual liberties.").

Section 1052(a) restricts Dykes on Bikes' ability to self-identify in their own political speech while preventing commercial exploitation of their branded name by others. It does so by penalizing their mark based on its content and limiting the organization's expressive activity based on the offense that examiners imagine an audience might experience from their choice of words. This is an impermissible content- and viewpoint-based restriction on speech. The First Amendment does not permit government to regulate or punish speech solely because it may give "serious offense." To the contrary, "a principal function of free speech under our system of government is to invite dispute." *Texas v. Johnson*, 491 U.S. 397, 408–409 (1989). In *Forsyth County v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992), this Court reiterated that "[l]isteners' reaction to speech is not a content-neutral basis for regulation" and explained that "[s]peech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob." Section 1052(a) places financially burdensome limitations on the ability of Dykes on Bikes to control the use of its mark and preserve its brand and its name for political

and social purposes without the dilution that comes from unauthorized commercial exploitation. Dykes on Bikes seeks to use its mark to engage in a vital public debate over the very meaning of the word "dyke" to lesbians today.

2. The Court should not allow the government to justify such viewpoint- and content-based restrictions on the false premise that all trademark use is exclusively commercial in nature. We recognize that other trademark owners, such as the Washington Redskins, may use controversial trademarks that are not self-referential for the more traditional goal of branding and selling goods and services for profit rather than engaging in political speech and social activism. We express no opinion on the constitutionality of regulating purely commercial speech, *compare Carey v. Population Services Int'l*, 431 U.S. 678, 701 (1977) ("At least where obscenity is not involved, we have consistently held that the fact that protected [commercial] speech may be offensive to some does not justify its suppression.") *with Board of Trustees of State University of New York v. Fox*, 492 U.S. 469, 475 (1989) (upholding rule at state university that prohibits "Tupperware parties" in order to promote "an educational rather than commercial, atmosphere on SUNY's campuses"), or whether the manner in which the Redskins use their mark constitutes commercial speech.[2] But

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2. Nor do we endorse the use of the term "redskins" for a football team. Unlike The Slants and Dykes on Bikes, both of whom have chosen to reclaim self-referential terms as trademarks for the benefit of the groups those terms refer to, the Washington Redskins have chosen a term that is unrelated to the people who identify as members of the football team and is commonly understood to be a slur which members of the identified group have not reclaimed. Whatever the constitutionality of the PTO's treatment of the Redskins mark, the team's use of that name is immoral and Dykes on Bikes encourages the Washington Redskins to give up their trademarked name as a matter of respect and decency.

Section 1052(a) restrains more than commercial speech. As applied to Dykes on Bikes and similar organizations, the law burdens political speech and cannot be justified under the lesser scrutiny this Court has sometimes applied in a commercial setting.

Any rule governing what the PTO can or cannot register as a trademark must account for those who use their trademarks for political speech. The fact that some trademark owners may use their marks for exclusively commercial purposes cannot change the fact that Section 1052(a) restricts and burdens those engaged in political speech as well.

C. THE STANDARDLESS DISCRETION IN SECTION 1052(A)'S SPEECH LICENSING REQUIREMENT LEADS TO ARBITRARY APPLICATIONS

When one PTO examiner approves a trademark application for a phrase and another examiner rejects an application for using the exact same phrase, it is clear that "the peaceful enjoyment of freedoms which the Constitution guarantees [is] contingent upon the uncontrolled will of a [government] official," as this Court has prohibited on numerous occasions. *Shuttlesworth v. Birmingham*, 394 U.S. 147, 150 (1969) (quoting *Staub v. City of Baxley*, 355 U.S. 313, 322 (1958)); *see e.g.*, *City of Lakewood v. Plain Dealer Publishing Co.*, 486 U.S. 750, 764 (1988) ("[The government] may not condition that speech on obtaining a license or permit from a government official in that official's boundless discretion."); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 n.19 (1993).

On its face, Section 1052(a) does not provide the "narrow, objective, and definite standards to guide the licensing" that the Constitution requires for a speech licensing scheme. *Shuttlesworth*, 394 U.S. at 151. It prohibits "disparaging" trademarks, but whether a word is disparaging depends heavily on the speaker, the listener, and the context. The difference could even be as subtle as a difference in tone of voice. "Disparagement," by its very nature, is based on the speaker's subjective intent. Depending on the context and the speaker, the use of the term "dyke" can be either an act of self-identification and a claim of pride in group membership or a slur intended to hurt or silence a minority. To tell the difference, a government bureaucrat must engage in viewpoint discrimination, deciding what the term means to the person doing the speaking and their expressive purpose. This is precisely the kind of uncertain standard this Court has rejected in the past. For instance, in *Shuttlesworth*, this Court struck down an ordinance giving the City Commission the power to license parades or demonstrations guided by, among other factors, "decency, good order, [and] morals." *Id.* at 150. The situation is no different here. The government cannot give individual civil servants (a City Commission or the PTO) nearly unfettered discretion to withhold a government benefit (a parade license or trademark registration) based on vague moral standards ("decency, good order, [and] morals" or "immoral . . . , scandalous matter; or matter which may disparage"). *Compare id. with* 35 U.S.C. § 1052(a) *and* TMEP § 1203.03 (b)(i) (Oct. 2015).

The application of Section 1052(a) in practice confirms that delegating hundreds or thousands of discretionary free speech decisions to individual civil servants working

with no clear or objective standard inevitably leads to arbitrary application and irreconcilably inconsistent results. The PTO analyzed two applications from Dykes on Bikes using the exact same phrase and found that phrase disparaging in one application and not in another, even after the same evidence was put before it in both applications.

In 2007, after four years of explanations, evidence, appeals, and motion practice, the PTO finally agreed that the phrase "Dykes on Bikes" is not disparaging and issued a federal trademark registration certificate for the Dykes on Bikes' name. In 2013, it accepted a certificate of continuing use and incontestability. '803 FH, Notice of Acceptance (Nov. 15, 2013). Yet just two years later, Dykes on Bikes applied for a trademark in its logo and the PTO rejected it, finding that the phrase "Dykes on Bikes," which appears in the logo, is disparaging. That finding directly contradicts the PTO's previous finding. '566 FH, Office Action (Aug. 11, 2015).

This was a not a difference in evidence, nor of changing attitudes over time. Rather, the difference is attributable merely to the caprice of the different examiners considering the applications.

This, alone, should be sufficient evidence that Section 1052(a) confers unconstitutionally standardless discretion on PTO examiners. But it gets worse in light of the Trademark Manual of Examining Procedure, which defines a disparaging mark as one that "may" be considered disparaging to "a substantial composite" of a "referenced group." TMEP § 1203.03 (b)(i) (Oct. 2015). While this shift from the perspective of the speaker to

the perspective of the audience purports to offer a more neutral perspective, in fact it does no such thing. To begin, judging speech by the reaction of the audience is itself a content-based activity. *Forsyth County*, 505 U.S. at 134–35. Further, the law's decision to choose only a subset of the audience—the group members the term describes—adds additional ambiguity. It is ambiguous as to what group is to be considered—all women, all lesbians, or all lesbian motorcycle enthusiasts? What constitutes "a substantial composite" of a group is also ambiguous. More importantly, how is an individual trademark examiner to determine whether most lesbian motorcycle enthusiasts would take pride in the phrase "Dykes on Bikes," or be offended by it? How is an individual trademark examiner to determine whether any offended lesbian motorcycle enthusiasts constitute a "substantial" or "insubstantial" composite? Dykes on Bikes submitted dozens of declarations on this point, but the resolution of its applications still depended on the personal reaction of an examiner who audibly gasped in shock when Dykes on Bikes' lawyer told her that counsel is herself "a dyke." That examiner's supervisor justified the examiner's decision by stating that a search for "vulgar" and "dyke" on Google yields many results. The same is true for a search of "vulgar" and practically any other word such as "shoe," yet that does not transmute "shoe" into something generally vulgar (or disparaging).

The open-ended discretion of Section 1052(a) and the TMEP guidelines does not stop with the PTO's registration decision. The uncertainty extends indefinitely because any person can attempt to cancel a trademark—even an incontestable mark—at any time by claiming it is disparaging or scandalous. *See* 15 U.S.C. § 1064(3).

Section 1052(a) is an exception to the normal rule that a trademark cannot be challenged after five years of registration and continuous use. *Id.* Dykes on Bikes thus operates under the constant specter of some person asking to cancel its marks because he or she believes them to be disparaging. And indeed it has already faced such challenges. Although Dykes on Bikes has invested in and cultivated its trademarked name for more than 40 years, it has no idea how the PTO will rule if someone decides to challenge its mark in the PTO, particularly in light of the inconsistent rulings that the PTO has already issued on the mark. The survival of Dykes on Bikes' trademark depends entirely on the personal whim on whichever PTO examiner is assigned to the case if someone decides to challenge the trademark.

The Federal Circuit decision now on appeal held that the PTO's inconsistent application of Section 1052(a) chills speech because people are less likely to choose a trademark if it is uncertain whether the government will be willing to protect it. *See In re Tam*, 808 F.3d at 1342 n.7. In particular, it points out that the PTO denied trademark registration for HAVE YOU HEARD SATAN IS A REPUBLICAN, but granted the trademark application for THE DEVIL IS A DEMOCRAT, stating "all we need say about the uncertainty here, however, is that it contributes significantly to the chilling effect on speech." *Id.* at 1342. That particular example also underscores the danger of the "potential for invidious discrimination of disfavored subjects" where an individual bureaucrat makes decisions about whose speech the government favors and whose speech it does not. *City of Cincinnati*, 507 U.S. at 423 n.19.

Judge O'Malley and Judge Wallach's concurrence in *In re Tam* echoes the majority's concern, but explicitly states that Section 1052(a) should be held unconstitutionally vague. *In re Tam*, 808 F.3d at 1359–60. This Court's admonishments regarding vaguely drafted speech restrictions underscore the dangers of allowing individual PTO examiners standardless discretion. The PTO's arbitrary application of Section 1052(a) does not "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). Vagueness in government regulation can, standing alone, be a constitutional problem. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998) ("Under the First and Fifth Amendments, speakers are protected from arbitrary and discriminatory enforcement of vague standards."). The Constitution tolerates even less vagueness where, as here, "the law interferes with the right of free speech." *See Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498 (1982). No reasonable person can determine or predict what speech Section 1052(a) will allow and what speech it will prohibit. *Grayned*, 408 U.S. at 108. As a result, it is likely that speakers will self-censor and avoid trademarks they worry the PTO might cancel even if they invest time and goodwill for many years. *See In re Tam*, 808 F.3d 1341–43.

This Court has held that the First and Fifth Amendments protect people from this kind of vague and inconsistent law when it restricts speech. *See Finley*, 524 U.S. at 588 ("Under the First and Fifth Amendments, speakers are protected from arbitrary and discriminatory enforcement of vague standards."). As discussed further below, the same protections should

apply when such a vague and inconsistent law withholds a government benefit on the basis of the content of speech. *See Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech."); *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) ("[E]ven though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech. For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited. This would allow the government to 'produce a result which (it) could not command directly.'").

The experience of Dykes on Bikes with Section 1052(a) starkly illustrates the reasons for this Court's longstanding skepticism over poorly drafted government licensing schemes for speech, particularly those that target disfavored or unpopular messages. When a licensing scheme uses terms so vague that applicants will be unable to predict what content will or will not pass muster, the threat to First Amendment values is acute.

D. THE IMPORTANCE OF TRADEMARK REGISTRATION

Federal trademark registration provides substantial benefits that are particularly important to a small, politically-focused, non-profit organization such as Dykes

on Bikes whose resources are limited and therefore must pick and choose the legal battles it can afford to fight.

Some of these benefits of registration are defined in the statute. For instance, the Lanham Act expressly provides that trademark registration comes with a presumption of validity, nationwide priority, incontestability, proof that the mark has secondary meaning, and constructive notice to would-be infringers. The statute also allows a trademark holder to seek additional remedies against infringers.

Other benefits are more practical than legal. Potential users will often check the Principal Register at the PTO and will avoid using a trademarked term when they see it's registered, but they are much less likely to search for or discover who has common-law trademark rights, in part because it is impossible to know from a search what parties might have or claim to have common-law rights in a particular trademark.

Our experience in seeking to enforce our mark bears this out. It has often proved sufficient for Dykes on Bikes to point to its federal registration for its word mark to persuade obvious infringers to cease their unlawful activity. But merely asserting the right to common-law protection often does not have the same effect, as Dykes on Bikes learned when the PTO refused to register its logo trademark. In fact, many online companies like Zazzle.com, which sells user-designed t-shirts and other products online, refuse to honor takedown notices at all without proof of a federal trademark registration. Virtually all websites such as Zazzle.com, eBay, Etsy, CafePress, and Facebook request that a trademark

owner include a trademark registration number when requesting takedown of infringing items, and without one, the takedown may require more time, and may not be successful at all. Other online sites, such as ReverbNation.com require a trademark registration in order to accept a takedown notice. Trademark registration is also required to combat cyber squatting and to protect the mark from registration under newly issued domain extensions. For example, GoDaddy, one of the main domain name registrars in the U.S., requires that a trademark owner have a valid federal registration on the principal register in order to prevent another domain name registrant from using the owner's trademark in a domain name. When ICM Registry, working with ICANN (which oversees the system of domain name extensions such as .com, .net, and .gov) offered a controversial new internet domain extension, .xxx, the only way Dykes on Bikes was able to prevent having its trademark offered to the public with a .xxx domain extension was because they held a federal registration and could opt out during the "Sunrise B" period. Without the federal registration, their application to opt out would have been rejected. Registration by others of Dykes on Bikes using a .xxx domain name would have substantially harmed the political speech and public impression of Dykes on Bikes, and common law remedies would have been too little too late to prevent such harm. Thus, lack of trademark registration actually impedes a trademark owner's ability to enforce its mark in the digital market place and limits its ability to take advantage of the simple, inexpensive takedown notice methods most internet service providers have made available

Dykes on Bikes relies on trademark registration to

ensure that the public associates Dykes on Bikes only with its own speech and not with others' speech or unlicensed attempts to commercialize the mark. Without them, Dykes on Bikes cannot control its own public presence or dignity. The inability to finally resolve its (so-far) thirteen-year effort to register its marks has imposed real costs and burdens on Dykes on Bikes that the possible existence of a common law trademark cause of action does not redress. The difference between having a federal trademark registration and not having one has had a striking difference on Dykes on Bikes' ability to control what speech the public associates with the official Dykes on Bikes organization.

Trademark registration, then, is not merely a government subsidy, largesse that the government can grant or withhold on a whim. Registration is, as a practical matter, an integral part of the Lanham Act scheme for protecting trademarks. Denying registration imposes a substantial burden on small organizations like Dykes on Bikes. Congress cannot impose that burden because it disagrees with Dykes on Bikes' choice of name. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011) ("The First Amendment requires heightened scrutiny whenever the government creates 'a regulation of speech because of disagreement with the message it conveys.'" (citation omitted)); *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015) ("Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.").

It is no answer that the Lanham Act withholds benefits rather than imposes restrictions. That would elevate form over substance. It would make the constitutionality

of the statute turn on Congress' chosen phrasing rather than the statute's effect on speech. There is no difference between "deny[ing] a benefit to a person because of his constitutionally protected speech or associations" and "penaliz[ing] and inhibit[ing]" the exercise of free speech. *Perry*, 408 U.S. at 597. This Court has rejected this argument, holding that "even though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech." *Id.* at 597 (1972); *see also Speiser*, 357 U.S. at 518 ("To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech."); *Sorrell*, 564 U.S. at 566 ("Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content."); *id.* at 580 (holding impermissible a state law that "burdened a form of protected expression," while leaving "unburdened those speakers whose messages are in accord with its own views").

Congress having provided important rights to all trademark applicants through the registration process, this Court should not allow Congress and the PTO to deny those benefits to selected individual applicants because of viewpoint-based disagreements with their particular choice of trademark.

CONCLUSION

This Court should find that 15 U.S.C. § 1052(a) is unconstitutionally vague, an impermissible viewpoint- and content-based restriction on speech, and confers unconstitutionally standardless discretion on individual PTO examiners

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